

REMARKS

Summary

This response is in reply to the Office Action mailed June 1, 2006. Applicants have amended claims 1, 11, 21, and 37. Applicants have also canceled claims 9, 16, 25, and 41. Claims 17-20 have also been amended to correspond to the canceling of claim 16. Amended claim 1 recites the subject matter of canceled claim 9. Amended claim 11 recites the subject matter of canceled claim 16. Amended claim 21 recites the subject matter of claim 25. Amended claim 37 recites, in the context of a system, the subject matter of canceled claim 9 and some of the subject matter of claim 1. Support for the amendment made to claim 37 can also be found in the written description of the original application at page 9. No new matter has been entered as a result of these amendments. Claims 1-8, 10-15, 17-24, 26-40, and 42-43 are currently pending.

Claims 1-10: Rejections Under 35 U.S.C. § 103(a)

Claims 1-10 have been rejected under 35 U.S.C. § 103(a). Claims 1, 2, and 4 have been rejected as being unpatentable over Akiyama *et al.* (CA 2387386) in view of Reynolds *et al.* (U.S. Pat. No. 7,020,888). Claim 3 has been rejected as being unpatentable over Akiyama *et al.* in view of Reynolds *et al.* and in further view of Herz *et al.* (U.S. Pat. No. 6,088,722). Claims 5-8 and 10 have been rejected as being unpatentable over Akiyama *et al.* in view of Reynolds *et al.*, and in further view of Haas *et al.* (U.S. App. Pub. No. 2002/0063714). Claim 9 has been rejected as being unpatentable over Akiyama *et al.* in view of Reynolds *et al.*, and in further view of Daniels (U.S. Pat. No. 6,973,669). As Applicants have canceled claim 9, Applicants respectfully submit that the rejection against claim 9 is rendered moot. Applicants respectfully traverse the remaining rejections as to claims 1-8 and 10 in view of the following remarks and arguments. In particular, Applicants respectfully submit that amended independent claim 1 is allowable over Akiyama *et al.* in view of Reynolds *et al.*, and in further view of Daniels, and that because claim 1 is allowable, the claims that depend therefrom are also allowable.

With respect to claim 1, the Office Action states that Akiyama *et al.* discloses a method for enhancing a television broadcast program, but does not disclose "animated video content and data comprising an executable instruction set for rendering an animated video." *Office Action mailed June 6, 2006*, pp. 2-3. The Office Action then states that Reynolds *et al.* teaches animated video content and teaches data that comprises an executable instruction set for rendering animated video. *Id.* at p. 3. The Office Action states that neither Akiyama *et al.* nor Reynolds *et al.* teach the subject matter of claim 9. *Id.* at pp. 27-28. The Office Action relied

further on Daniels to reject dependent claim 9. *Id.* at p. 27. Since amended claim 1 now includes the subject matter of canceled claim 9, Applicants respectfully submit that amended claim 1 is allowable over at least Akiyama *et al.* in view of Reynolds *et al.* and in further view of Daniels. Applicants address the rejection with respect to Daniels below.

As to Daniels, the Office Action states that Daniels teaches

determining whether television broadcast program has resumed after end of the television break, determining whether the television break has ended, and if television break has not ended, storing the resumed television broadcast program on a storage device from a beginning point, and displaying the resumed broadcast program from the beginning point — col. 19, lines 26-55, col. 20, lines 6-40, col. 21, lines 11-23. *Id.* at p. 28.

The Office Action then states it would have been obvious to modify Akiyama *et al.* and Reynolds *et al.* to include the teachings of Daniels “for the advantage of allowing the user to not miss any portion of the television broadcast.” *Id.* Applicants respectfully traverse this rejection and submit that Daniels does not teach or suggest the limitation of claim 1 wherein the method includes “determining whether the television broadcast program has resumed after end of the television broadcast advertisement, determining whether the replacement advertising segment has ended, and if the replacement advertising segment has not ended, storing the resumed television broadcast program on a storage device from a beginning point, and displaying the resumed broadcast program from the beginning point.”

Daniels is generally directed to a time shifting event recorder capable of recording portions of a time sequential signal representing an event so that a representation of the event can be produced in a time shifted manner. *U.S. Pat. No. 6,973,669*, col. 4, ll. 5-8. According to Daniels, “the viewer has control over how a movie or television show is viewed in a manner that is not conventionally possible. If a particularly interesting or complex scene occurs, the viewer can replay it, and then return to the movie without missing any of it. If the phone rings, the viewer can pause the display of the television show, and then return to uninterrupted viewing of it at any future time, even while the rest of the show is being received, and not miss anything.” *Id.* at col. 4, ll. 14-22.

The Office Action cites to col. 19, ll. 26-55, col. 20, ll. 6-40, and col. 21, ll. 11-23 of Daniels as forming the basis of the rejection under Daniels. However, the citations to Daniels demonstrate that Daniels does not teach or suggest the subject matter of canceled claim 9, now incorporated into amended claim 1. The text of col. 19, ll. 26-55 is reproduced below:

FIG. 6 is a flow chart showing the operation of the inventive apparatus for pausing the display of a time sequential signal, and illustrates the inventive method for pausing the display of a time sequential signal. In accordance with the present invention(s), a time sequential signal is received via, for example, an antenna, a cable television hook up, Internet modem connection, satellite transmission or other

information transfer mechanism. The information depending on time sequential signal is displayed for viewing on a television, computer monitor, radio, or other displaying device 44. **A pause display command is inputted by the viewer through, for example, a remote control, keyboard, voice activation, or other command inputting mechanism. Thus, the viewer selects "break" (step one).** A first start-recording value is set (RM1) (step 2). A beginning of a first recorded portion of the time sequential signal is recorded on a first recording medium 16 (begin recording TSS on RM1 (step 3)). At this point, the viewer can attend to a phone call, or otherwise take a break from viewing the program, while the program continues to be broadcast and received as the time sequential signal. The portion of the time sequential signal that occurs during the break is recorded on the first recording medium 16.

When the viewer returns, a resume display command is inputted (viewer selects "return" Step 4)). An ending of the first recorded portion of the time sequential signal is then recorded on the first recording medium 16. When the ending of the first recorded portion of the time sequential signal is recorded, a stop-recording value can be set (set RM1) stop-recording value (Step 5)). However, it is not necessary. (emphasis added). *Id.* at col. 19, ll. 26-55.

The text of col. 20, ll. 6-40 is reproduced below:

The ending of the first recorded portion is recorded on the first recording medium 16 and recording of the time sequential signal on the first recording medium 16 is stopped (stop recording TSS on RM1 (step six)). The first and the second recording mediums 16,22 may be the same disk or recording mechanism, as described herein.

Next, a second start-recording value is set (set RM2 start-recording value (step 7)). A beginning of a second recorded portion of a time sequential signal is recorded on a second recording medium 22 (begin recording on TSS on RM2 (step eight)). **To recap what has occurred, a viewer or user has determined to take a pause in the display of the continuously aired program. Thus, a pause display command is inputted, and the viewer selects "break" (step one).** A first start-recording value is set (step two) and a beginning of the first recorded portion of a time sequential signal is recorded on a first recording medium 16 (step three). When the viewer returns, a resume display command is inputted (step 4) a stop-recording value may be set (depending on the construction of the inventive apparatus), and the ending of the first recorded portion is recorded on the first recording medium 16 (steps 5 and 6). **Since the viewer has inputted a resume display command and wishes to continue viewing the program from where the beginning of the break began, a second recorded portion of the time sequential signal must be recorded so that the portion of the continuously received signal is stored for time shifted or asynchronous viewing.** Thus, a second start-recording value is set, and a beginning of a second recorded portion of the time sequential signal is recorded on a second recording medium 22. **To allow the viewing to begin watching the program again, from the point the arbitrary break was taken, the beginning of the first recorded portion must be determined.** This beginning is determined using the first start-recording value. Thus, RM1 is returned to the start-recording value (step 9). (emphasis added). *Id.* at col. 20, ll. 6-40.

In order to establish a *prima facie* case of obviousness, "all the claim limitations must be taught or suggested by the prior art." See *Manual of Patent Examination and Procedure* § 2143.03 (hereinafter "MPEP"). The two excerpts above demonstrate that Daniels does not teach or suggest the limitation of "determining whether the television broadcast program has resumed after end of the television broadcast advertisement, determining whether the replacement advertising segment has ended, and if the replacement advertising segment has not ended, storing the resumed television broadcast program on a storage device from a beginning point, and displaying the resumed broadcast program from the beginning point." Instead, the excerpts above illustrate that user intervention is required in the system disclosed by Daniels to begin recording the television program. As succinctly stated above, "the viewer selects 'break'." In contrast, the limitation amended into claim 1 recites "determining whether the replacement advertising segment has ended, and if the replacement advertising segment has not ended, storing the resumed television broadcast program on a storage device from a beginning point." Hence, the system disclosed in Daniels records and resumes a television program based on user input, whereas the system claimed in amended claim 1 records and displays a resumed television broadcast program based on determining whether the replacement advertising segment has ended.

Further Daniels teaches that the program is stored and resumes from the point where the program is paused or at the break. In contract, claim 1 recites **not** that the program is stored and resumes from the point where the break begins and the advertisement begins, but rather that the program is stored when the replacement advertising segment has not ended, but the television broadcast program has resumed. Daniel teaches a user selection to pause and begin storing a program being currently viewed. In contrast, claim 1 recites to begin storing a program that is not being viewed, but while a replacement segment is being viewed and at a later point in time after the break in the television broadcast program if certain conditions are present. Daniel fails to teach or suggest such a modification.

Accordingly, amended claim 1 is allowable over Akiyama *et al.* in view of Reynolds *et al.*, and in further view of Daniels. As amended claim 1 is allowable, claims 2-8 and 10 are also allowable for at least the same reason.

Claims 11-20: Rejections Under 35 U.S.C. § 103(a)

Claims 11-20 have been rejected under 35 U.S.C. § 103(a). Claims 11, 12, and 14 have been rejected as being unpatentable over Akiyama *et al.* in view of Reynolds *et al.* Claim 13 has been rejected as being unpatentable over Akiyama *et al.* in view of Reynolds *et al.*, and in further view of Herz *et al.* Claim 15 has been rejected as being unpatentable over Akiyama *et al.* in view

of Reynolds *et al.*, and in further view of Beach (U.S. Pat. No. 6,728,713). Claims 16 and 19-20 have been rejected as being unpatentable over Akiyama *et al.* in view of Reynolds *et al.* and in further view of Daniels. Claim 17 has been rejected as being unpatentable over Akiyama *et al.* in view of Reynolds *et al.* and Daniels, and in further view of Haas *et al.* Claim 18 has been rejected as being unpatentable over Akiyama *et al.* in view of Reynolds *et al.* and Daniels, and in further view of Plotnick *et al.* (U.S. App. Pub. No. 2005/0097599).

As Applicants have canceled claim 16, Applicants respectfully submit that the rejection against claim 16 is rendered moot. Applicants respectfully traverse the remaining rejections as to claims 11-15 and 17-20 in view of the following remarks and arguments. In particular, Applicants respectfully submit that amended independent claim 11 is allowable over Akiyama *et al.* in view of Reynolds *et al.*, and in further view of Daniels, and that because claim 11 is allowable, the claims that depend therefrom are also allowable.

With respect to claim 11, the Office Action states that Akiyama *et al.* discloses a method for enhancing a television broadcast program, but does not teach "executable instructions sets for generating data, and rendering on a local processor the data by executing the executable instruction sets." *Office Action mailed June 6, 2006*, pp. 4-5. The Office Action then states that Reynolds *et al.* teaches data having an executable instruction set for rendering animated video processed by a local processor. *Id.* at p. 5. With respect to claim 16, the Office Action states that neither Akiyama *et al.* nor Reynolds *et al.* teach the subject matter of canceled claim 16. *Id.* at p. 27-28. However, the Office Action states that Daniels teaches this subject matter. *Id.* at p. 28. Applicants traverse the rejection with respect to Daniels as applied to the subject matter of claim 16, which is incorporated into claim 11, for at least two reasons.

First, the limitation cited by the Office Action that Daniels supposedly teaches is not the limitation of claim 16. The limitation cited by the Office Action is "determining whether television broadcast program has resumed after end of the television break, determining whether the television break has ended, and if the television break has not ended, storing the resumed television broadcast program on a storage device from a beginning point, and displaying the resumed broadcast program from the beginning point," *Id.* at p. 28, whereas the limitation of canceled claim 16, which is incorporated into amended claim 11, is "determining whether a next sequential program segment in the television broadcast program has commenced after end of the blocked television broadcast segment, determining whether replacement segment has ended, and if replacement segment has not ended, storing the next sequential program segment on a storage device from a beginning point, and displaying the next sequential segment from the beginning point after the replacement segment has ended."

Under 35 U.S.C. § 103, an applicant is entitled to a patent “unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations.” (emphasis in original). *In re Ochiai*, 37 U.S.P.Q. 2d 1127, 1133 (Fed. Cir. 1995). As the subject matter of canceled claim 16 contains limitations that are different from the limitations cited by the Office Action, Applicants respectfully submit that canceled claim 16 was improperly rejected. Since amended claim 11 includes the subject matter of improperly rejected, but now canceled, claim 16, claim 11 is believed allowable. As claim 11 is believed allowable, dependent claims 12-15 and 17-20 are also allowable for at least this first reason.

Second, even if Daniels were properly applied to the subject matter of canceled claim 16, Applicants respectfully submit that Daniels does not teach or suggest that subject matter. In order to establish a *prima facie* case of obviousness, “all the claim limitations must be taught or suggested by the prior art.” See *MPEP* § 2143.03. As discussed previously with respect to claim 1, the system in Daniels requires user intervention to begin recording and resuming the television program. In contrast to the user intervention required by Daniels, the limitation amended into claim 11 requires “determining whether replacement segment has ended, and if replacement segment has not ended, storing the next sequential program segment on a storage device from a beginning point.” Daniels requires a user input to selectively pause a viewed program to begin storing it, while claim 11 recites that the stored program has been previously blocked from viewing when it begins to be stored. Thus, in contrast to the system disclosed in Daniels, which begins recording and resuming a television program based on user input while viewing the television program, the method claimed in amended claim 11 requires recording and displaying of a next sequential program segment based on determining whether the replacement segment has ended while the next sequential program is not being viewed.

Accordingly, for at least this second reason, amended claim 11 is believed allowable over *Akiyama et al.* in view of *Reynolds et al.*, and in further view of Daniels. As amended claim 11 is allowable, dependent claims 12-15 and 17-20 are also allowable for at least this second reason.

Claims 21-36: Rejections Under 35 U.S.C. § 103(a)

Claims 21-36 have been rejected under 35 U.S.C. § 103(a). Claims 21, 25, 27, and 28 have been rejected as being unpatentable over Mankovitz (WO 98/48566) in view of *Reynolds et al.* and in further view of *Shoff et al.* (U.S. Pat. No. 6,240,555). Claim 22 has been rejected as being unpatentable over Mankovitz in view of *Reynolds et al.* and *Shoff et al.*, and in further view of *Srinivasan et al.* (U.S. Pat. No. 6,357,042). Claim 23 has been rejected as being unpatentable

over Mankovitz in view of Reynolds *et al.* and Shoff *et al.*, and in further view of Griggs (U.S. App. Pub. No. 2002/0029384). Claim 24 has been rejected as being unpatentable over Mankovitz in view of Reynolds *et al.* and Shoff *et al.*, and in further view of Hidary *et al.* (U.S. Pat. No. 5,774,664). Claim 26 has been rejected as being unpatentable over Mankovitz in view of Reynolds *et al.* and Shoff *et al.*, and in further view of Akiyama *et al.* Claims 29 and 35 have been rejected as being unpatentable over Mankovitz in view of Reynolds *et al.* and Shoff *et al.*, and in further view of Deo *et al.* (U.S. Pat. No. 6,832,084). Claim 30 has been rejected as being unpatentable over Mankovitz in view of Reynolds *et al.*, Shoff *et al.*, Deo *et al.*, and in further view of Ebert (U.S. Pat. No. 6,539,423). Claim 31 has been rejected as being unpatentable over Mankovitz in view of Reynolds *et al.*, Shoff *et al.*, Deo *et al.*, and in further view of Dias *et al.* (U.S. Pat. No. 6,122,011). Claim 32 has been rejected as being unpatentable over Mankovitz in view of Reynolds *et al.*, Shoff *et al.*, Deo *et al.*, and in further view of Zellner *et al.* (U.S. Pat. No. 6,738,808). Claim 33 has been rejected as being unpatentable over Mankovitz in view of Reynolds *et al.*, Shoff *et al.*, Deo *et al.*, Zellner *et al.*, and in further view of Kwok *et al.* (U.S. Pat. No. 6,829,711). Claim 34 has been rejected as being unpatentable over Mankovitz in view of Reynolds *et al.*, Shoff *et al.*, Deo *et al.*, Zellner *et al.*, Kwok *et al.*, and in further view of Ward *et al.* (U.S. App. Pub. No. 2003/0093353). Claim 36 has been rejected as being unpatentable over Mankovitz in view of Reynolds *et al.*, Shoff *et al.*, and Kwok *et al.*

As Applicants have canceled claim 25, Applicants respectfully submit that the rejection against claim 25 is rendered moot. Applicants respectfully traverse the remaining rejections as to claims 21-24 and 26-36 in view of the following remarks and arguments. In particular, Applicants respectfully submit that amended independent claim 21 is allowable over Mankovitz in view of Reynolds *et al.* and in further view of Shoff *et al.* As claim 21 is allowable, the claims that depend therefrom are also allowable.

With respect to the rejection of claim 21, the Office Action states that Mankovitz discloses a method for enhancing a television broadcast program, but does not teach "data comprising an executable instruction set and processing animated video from the executable instruction set." *Office Action mailed June 6, 2006*, pp. 11-12. The Office Action then states that Reynolds *et al.* "teaches data comprising an executable instruction set for rendering animated video is processed by a local processor." *Id.* at p. 12. However, the Office Action states that neither Mankovitz nor Reynolds *et al.* teach "wherein supplemental content overlays portions of the television program." *Id.* The Office Action then relies on Shoff *et al.* to show "wherein supplemental content partly overlays the television program in order to provide supplemental information along with the television program." *Id.* at p. 13. As amended claim 21

now includes the subject matter of now canceled claim 25, Applicants address the rejection as to claim 25 below.

With respect to the subject matter of canceled claim 25, which is incorporated into amended claim 21, the Office Action states that "Mankovitz discloses a method comprising synchronizing the starting time and ending time for display of the supplemental video content with a portion the television program wherein the supplemental video content is informationally related to the synchronized portion of the television program — p. 6, lines 25-30." *Id.* Applicants respectfully disagree and submit that Mankovitz does not, in fact, teach this limitation. The citation to Mankovitz on which the Office Action relies for rejecting the subject matter of now canceled claim 25 is reproduced below:

After 20 a website name is selected, the viewer presses a button on the viewer input device. As a result, the website address to which the selected website name is linked is retrieved from memory 36 by microprocessor 24 and sent through the telephone or cable interface to Internet service provider 33. (If desired, this function of microprocessor 24 could be carried out by commercial equipment sold under the trademark WEB TV.) The information at the addressed website is downloaded from Internet service provider 33 over link 34 to microprocessor 24 and **then displayed on the screen simultaneously with the television 30 program to which the information relates.** as illustrated in FIG. 3. after being composed by video processor 30. (emphasis added). WO 98/48566, p. 6., ll. 19-31.

This excerpt from Mankovitz merely shows that the information selected by a viewer is displayed simultaneously with a television program. This excerpt does not, in fact, show that the starting time and ending time of the information displayed simultaneously with the television program is synchronized with a portion of the television program. In order to establish a *prima facie* case of obviousness, "all the claim limitations must be taught or suggested by the prior art." See MPEP § 2143.03. As Mankovitz discloses, user intervention is required in order to display the information simultaneously with the television program. Accordingly, the display of the information displayed on the screen simultaneously with the television program is not based on synchronizing the starting time and ending time of the information with a portion of the television program, but dependent on user input that is not taught to be synchronized with the starting time and ending time. Hence, Mankovitz does not teach or suggest the limitation of amended claim 21 of "synchronizing the starting time and ending time for display of the supplemental video content with a portion of the television program, wherein the supplemental video content is informationally related to the synchronized portion of the television program." Thus, Applicants respectfully submit that amended claim 21 is allowable over Mankovitz in view of Reynolds *et al.* and in further view of Shoff *et al.* As claim 21 is allowable, dependent claims 22-24 and 26-36 are also allowable.

Claims 37-43: Rejections Under 35 U.S.C. § 103(a)

Claims 37-43 have been rejected under 35 U.S.C. § 103(a). Claims 37 and 40-42 have been rejected as being unpatentable over Mankovitz in view of Reynolds *et al.* Claim 38 has been rejected as being unpatentable over Mankovitz in view of Reynolds *et al.* and in further view of Pendakur *et al.* (U.S. App. Pub. No. 2003/0016673). Claim 39 has been rejected as being unpatentable over Mankovitz in view of Reynolds *et al.* and Akiyama *et al.* Claim 43 has been rejected as being unpatentable over Mankovitz in view of Reynolds *et al.* and in further view of Huang *et al.* (U.S. Pat. No. 6,437,836).

As Applicants have canceled claim 41, Applicants respectfully submit that the rejection against claim 41 is rendered moot. Applicants respectfully traverse the remaining rejections as to claims 37-40 and 42-43 in view of the following remarks and arguments. In particular, Applicants respectfully submit that amended independent claim 37 is allowable over Mankovitz in view of Reynolds *et al.*, and, should it be prospectively applied, in further view Daniels. As claim 37 is allowable, the claims that depend therefrom are also allowable.

With respect to the rejection of claim 37, the Office Action states that Mankovitz discloses a system for displaying enhanced television broadcast programs but “fails to teach content comprising executable instruction sets and animated video content.” *Office Action mailed June 1, 2006*, pp. 23-24. The Office Action then states that “Reynolds additionally teaches data comprising an executable instruction set for rendering animated video is processed by a local processor.” *Id.* at p. 24. However, amended claim 37 includes similar subject matter as claim 1 and now canceled claim 9, and, as previously discussed, neither Mankovitz nor Reynolds *et al.* disclose the limitation of “a multimedia controller . . . wherein the multimedia controller is further operative to determine whether the television broadcast program has resumed after the end of the television broadcast advertisement, to determine whether the replacement advertising segment has ended, and if the replacement advertising segment has not ended, to store the resumed television broadcast program on the first memory storage from a beginning point, and to display the resumed broadcast program from the beginning point.” Accordingly, Applicants respectfully submit that amended claim 37 is allowable over at least Mankovitz and Reynolds *et al.*

Although claim 37 is allowable over at least Mankovitz and Reynolds *et al.*, amended claim 37 also includes the subject matter of now canceled claim 9, which was rejected based on the application of Daniels. Assuming, *arguendo*, that Daniels were applied to amended claim 37, Applicants respectfully submit that Daniels does not teach or suggest the limitation of claim 37 of “wherein the multimedia controller is further operative to determine whether the television

broadcast program has resumed after the end of the television broadcast advertisement, to determine whether the replacement advertising segment has ended, and if the replacement advertising segment has not ended, to store the resumed television broadcast program on the first memory storage from a beginning point, and to display the resumed broadcast program from the beginning point." As previously discussed with respect to claim 1, the system of Daniels requires user intervention to record the television program being viewed and then later resume the program. In order to establish a *prima facie* case of obviousness, "all the claim limitations must be taught or suggested by the prior art." See *Manual of Patent Examination and Procedure* § 2143.03 (hereinafter "MPEP"). In contrast to the system disclosed in Daniels, which records and resumes a television program based on user input, the system of claim 37 records and displays the television broadcast program based on whether the replacement advertising segment has ended, the recording being initiated while the program is blocked and not being viewed by the user.

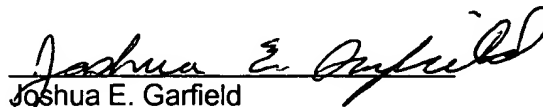
Accordingly, amended claim 37 is allowable over Mankovitz in view of Reynolds *et al.*, and, if applied, in further view of Daniels. As amended claim 37 is allowable, dependent claims 38-40 and 42-43 are also allowable.

Conclusion

Therefore, in view of the above amendment and remarks, Applicants respectfully submit that this application is in condition for allowance and such action is earnestly requested.

If for any reason the Examiner is not able to allow the application, he is requested to contact the Applicants' undersigned attorney at (312) 321-4200.

Respectfully submitted,


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